

10 DEC 2003

#9



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
P.O. Box 1450  
ALEXANDRIA, VA 22313-1450  
www.uspto.gov

David J. Heller  
c/o Ridout & Maybee  
One Queen Street East, Suite 2400  
Toronto Ontario CANADA  
M5C 3B1

In re Application of  
Howard Kaplan (deceased)  
Application No.: 10/070,503  
PCT No.: PCT/CA00/01027  
Int. Filing Date: 07 September 2000  
Priority Date: 07 September 1999  
Attorney Docket no.: 33956-0049  
For: ENHANCED PHAGE DISPLAY  
LIBRARY OF HUMAN VH FRAGMENTS  
AND METHODS FOR PRODUCING

DECISION ON  
RENEWED PETITION  
UNDER 37 CFR 1.42  
AND PETITION UNDER  
37 CFR 1.47(a)

This is a decision on applicant's "Petition to Accept Declaration under 37 CFR 1.497, 1.42 & 1.47(a)", filed in the United States Patent and Trademark Office (USPTO) on 08 October 2003.

### **BACKGROUND**

On 07 March 2002, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee. In response to the Notification of Missing Requirements mailed on 12 June 2002, and to satisfy the requirement that an oath or declaration of the inventors be furnished, applicant filed a declaration on 12 August 2002 that was signed by inventors Joycelyn Entwistle, Jamshid Tanha, Saran Narang, Michael Dan and identifying Carole Grad as legal representative for deceased inventor Howard Kaplan. The submission was treated as a request for status under 37 CFR 1.42.

On 24 December 2002, a decision on applicant's submission was mailed indicating that the declaration was unacceptable because it was not signed by Carole Grad as legal representative for deceased inventor Howard Kaplan and did not clearly state the country of citizenship, former residency and mailing address of both the deceased inventor and the legal representative, as required for compliance with 37 CFR 1.497.

On 24 March 2003, applicant filed a renewed request, accompanied by a handwritten alteration to the originally filed declaration and a statement by counsel that the legal representative's refuses to sign the declaration. On 08 August 2003, a decision was mailed to applicant dismissing the petition on the grounds that a petition under 37 CFR 1.47(a) was appropriate where the legal representative of a deceased inventor refuses to make application.

On 08 October 2003, applicant filed a "Petition to Accept Declaration under 37 CFR 1.497, 1.42 & 1.47(a)" requesting acceptance of the declaration without the signature, Carole Grad, the legal representative of deceased inventor Howard Kaplan.

### DISCUSSION

37 CFR § 1.42 requires that in the case of the death of the inventor, the legal representative of the deceased inventor may make the necessary oath or declaration, and apply for and obtain a patent. In the circumstance, where the legal representative is uncooperative and refuses to sign the declaration on behalf of the deceased inventor, the proper submission is a petition under 37 CFR 1.47. As stated in MPEP §409(c), 35 CFR 1.47 applies where a known legal representative of a deceased inventor refuses to make application. In such cases, the last known address of the legal representative must be given.

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(h), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s). See MPEP §409.03 Unavailability of Inventor.

Applicant has satisfied items (1) through (4) above with the requisite petition fee, a statement from the legal representative indicating her refusal to sign the declaration, statement of the last known address of the legal representative and a declaration executed by the joint inventors.

Petitioner has satisfied the requirements of 37 CFR 1.47(a). Accordingly, it is appropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.


### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is GRANTED. The petition under 37 CFR §1.47(a) is GRANTED.

The U.S. Designated/Elected Office is authorized to accept the application as a 37 CFR 1.47(a) application using the declaration filed 23 October 2003 and to mail a filing receipt. The application has an international filing date of 07 September 2000 under 35 U.S.C. 363, and a date of 23 October 2003 under 35 U.S.C. 371(c).

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the non-signing inventors at their respective last known address of record. Also, a notice of the filing of this application will be published in the Official Gazette.

The application is being returned to the International Division for processing as the U.S. National Stage of the above-identified international application.

  
Cynthia M. Kratz  
Attorney Advisor  
PCT Legal Office

Telephone: (703) 306-5467